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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/100,595 06/19/98 BIGUS

J IBM/04B

LM02/0401

EXAMINER

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STARKS, W

ART UNIT

PAPER NUMBER

2762

DATE MAILED:

04/01/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/100,595</b>	Applicant(s) <b>BIGUS, Joseph Phillip et al.</b>
	Examiner <b>Wilbert L. Starks, Jr.</b>	Group Art Unit <b>2762</b>

Responsive to communication(s) filed on Jun 19, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 30-32 and 36-48 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 30-32 and 36-48 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. Claims 1-29 and 33-35 have been canceled by applicant in preliminary amendment filed 25 July 1998. Claims 30-32 and 36-48 have been examined.

#### *Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It was not executed in accordance with either 37 CFR 1.66 or 1.68. The signatures are photocopies of the originals.

3. The disclosure is objected to because of the following informalities:

The specification does not state that the application is a divisional of another application.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the invention as disclosed in claim 30 is directed to non-statutory subject matter. While the claims are in the technological arts, they are not limited to practical applications in the technological arts.

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The claims are series of steps to be performed on a computer, but they disclose no manipulation of data or data representing physical objects or activities to achieve a practical application (pre-computer activity), nor do they disclose any independent physical acts being performed by the invention (post-computer activity). The claims merely manipulate abstract ideas in general without limitation to a practical application.

While the claim does recite that it is a “computer program product”, it is claimed to be embodied on “signal bearing media”. This is not the same as being on a “computer readable medium”, as required under 35 U.S.C. 101. A program embodied on a “computer readable medium” is a physical object that, when placed in the computer, causes the computer to operate in a particular fashion. On that basis, a claim for a computer program on a computer readable medium is a “product of manufacture” type of claim and is, therefore, statutory. A “signal bearing medium” is broader than this in that it may or may not be computer readable and therefore would fail to be a “product of manufacture” and would, therefore be non statutory.

On this basis, claim 30 is held to be nonstatutory. Claims 31-32 and 36-48 do not cure the defect in claim 30. On this basis, claims 30-32 and 36-48 are rejected under 35 USC 101.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 30, 36-37, and 39-47 are rejected under 35 U.S.C. 102(a) as being anticipated by Bonnell et al. (U.S. Patent Number 5,655,081; Dated 08/05/97). Specifically, claim 30's intelligent agent "configured to handle common computer tasks" is anticipated by Bonnell et al., Abstract and claim 11.

Claim 36's "evaluation module" is anticipated by Bonnell et al.col. 16, lin. 61-65.

Claim 37's learning module is anticipated by Bonnell et al. col. 2, lin. 33-36.

Claim 39's "evaluation module" used to select program modules is anticipated by Bonnell et al.col. 16, lin. 61-67; col. 17, lin. 1-24.

Claims 40-42 "agent manager" features are anticipated by Bonnell et al.col. 16, lin. 61-65.

Claims 43-45 "agent manager" features are anticipated by Bonnell et al. Fig 7, element 110.

Claims 46's intelligent agent "configured to handle common computer tasks" is anticipated by Bonnell et al., Abstract and claim 11. The rest of claim 46 regarding its use in electronic commerce is simply a field of use statement and does not claim a new design feature. On this basis, the claim is also objected to for failing to further limit its base claim, claim 30.

Claim 47's dependent, semi-autonomous, and fully autonomous program modules are anticipated by Bonnell et al., Abstract. Such program modules are within the scope of that disclosure.

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***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - A. Seiffert et al. (U.S. Patent Number 5,729,472; Dated 03/17/98) discloses a monitoring architecture.
  - B. Colpien et al. (U.S. Patent Number 5,093,914; Dated 03/03/92) discloses a method of controlling the execution of object-oriented programs.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilbert L. Starks, Jr. whose telephone number is (703) 305-0027. Alternatively, inquiries may be directed to Supervising Patent Examiner Tariq Hafiz whose telephone number is (703) 305-9643.

wls

March 25, 1999



Tariq R. Hafiz  
Supervisory Patent Examiner  
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